

REMARKS

Claims 9-11, 13, 14, and 16-20 are pending in the application.

Claims 9-11, 13, 14, and 16-20 have been rejected.

Claims 14 and 17 have been amended.

Unless otherwise specified in the below discussion, Applicants have amended the above-referenced claims in order to provide clarity or to correct informalities in the claims. Applicants further submit that, unless discussed below, these amendments are not intended to narrow the scope of the claims. By these amendments, Applicants do not concede that the cited art is prior to any invention now or previously claimed. Applicants further reserve the right to pursue the original versions of the claims in the future, for example, in a continuing application.

Rejection of Claims Under 35 U.S.C. §103

Claims 9-11, 13, 14 and 16-20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Microsoft PowerPoint 2000, "Selling an Idea for a Product," March 10, 1999, pages 1-19 ("MPP2000") in view of U.S. Patent No. 6,938,032 issued to Heath et al. ("Heath") in further view of U.S. Patent No. 6,490,601 issued to Markus et al. ("Markus"). Applicants respectfully traverse this rejection.

In order for a claim to be rendered invalid under 35 U.S.C. §103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. §103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation

of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Independent Claims 9, 14 and 17 provide claim limitations of substantially the following form:

in response to a command to generate a slide presentation for the presentation target, the computer performing the acts of

determining whether to include each of the plurality of component definitions in the slide presentation based on its associated query condition; and

for each of the component definitions determined to be included in the slide presentation, automatically replacing the associated information bookmark with its mapped opportunity-specific data to generate the slide presentation, wherein

said determining uses the opportunity-specific data, and

said determining and said replacing are performed without human interaction.

See, e.g., Claim 1. Applicants respectfully submit that neither MPP2000, Heath nor Markus, alone or in combination, contain disclosure of these limitations.

Applicants submit that the combination of references does not teach the limitation: “in response to a command to generate a slide presentation for the presentation target, the computer performing the acts of determining whether to include each of the plurality of component definitions in the slide presentation based on its associated query condition ..., wherein ... said determining and said replacing are performed without human interaction.” As an initial matter, the Office Action admits that MPP2000 “does not specifically teach a means... for determining whether to include each of a plurality of component definitions in the slide presentations based on the query condition” (*see* Office Action, p.3), a proposition with which Applicants agree.

The Office Action then relies upon disclosure within Heath for purportedly supplying the above claim limitation, along with others related to the “query condition” claim element. Applicants respectfully submit that none of the cited sections of Heath provides disclosure of the claimed determining being performed by a computer without human interaction, as claimed. As cited by the Office Action, Heath provides disclosure related to purportedly searching a predetermined topic list or a key word in order to retrieve slides conforming to the search. *See* Heath 4:3-8; 4:17-21. The user then performs a selection process of the found slides that they wish to include in a presentation. *See* Heath 4:18-30. Applicants respectfully submit that throughout this disclosed process, the user provides the search criteria and manually performs the selection of the slides desired to be included in a slide presentation. Thus, the cited sections of Heath provide no disclosure of the computer performing the selection process without human interaction.

The Office Action even states “the user selects the query and then the computer, via the search string, ‘determines’ the appropriate slides.” Office Action, p.3. Thus, the Office Action admits that Heath requires human interaction to perform the disclosed tasks, which is clearly contrary to the claim limitation. In order to avoid this inevitable result, the Office Action then argues the following:

Conversely, any supposed automatic step preceded by a user interaction is itself performed with user interaction. Thus in the independent claims the selection of the presentation target could be considered to nullify the without interaction limitations for the determining and replacing steps.

Office Action, p.7. Applicants respectfully submit that in no way do the independent claims contain limitations that “nullify” the “without human interaction” element associated with the “determining” and “replacing” limitations.

First, the independent claims do not contain any limitation directed toward “selection of the presentation target” as suggested by the Office Action. Thus, the Office Action is arguing “nullification” of an explicit claim limitation by incorporating a non-existent limitation into the claim. To the extent that the Office Action is doing so by incorporating a “selection of the presentation target” limitation into the claim from the specification, this is improper under current patent law. *See, e.g., Sjolund v. Musland*, 847 F.2d 1573, 1581 (Fed. Cir. 1988) (“While it is true that claims are to be interpreted in light of the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims....”).

Second, the structure of the claim limitation makes it clear that the “computer performing the acts of” and the “without human interaction” claim elements are directed specifically toward the “determining” and “replacing” claim limitations. Thus, even were a “selection of the presentation target” limitation read into the claims, it would not serve to “nullify” the specific relationship between the “determining” and “replacing” claim limitations and the “computer performing the acts of” and “without human interaction” elements. By citing Heath against these limitations, the Office Action ignores this specific relationship by providing a reference that clearly does not disclose these elements.

Applicants also respectfully submit that the combination of references does not provide disclosure of the claim limitation: “in response to a command to generate a slide presentation for the presentation target, the computer performing the acts of determining whether to include each of the plurality of component definitions in the slide presentation based on its associated query condition ..., wherein said determining uses the opportunity-data” The Office Action admits that neither MPP2000 nor Heath, alone

or in combination, teaches this claim limitation, a proposition with which Applicants agree. *See* Office Action, p.4. The Office Action then cites to a combination of Heath with Markus as providing disclosure of this limitation. *See id.* As an initial matter, the sections of Heath cited in the Office Action for the “determining” limitation do not provide disclosure of a “computer performing the acts of” such “determining,” nor “without human interaction” as discussed above. *See* Heath 4:3-9 (disclosing a user clicking on a presentation to view slides and a user performing a search); Heath 4:17-20 (“the user has performed a keyword search ... and has retrieves [sic] a group of slides from several different presentations.”). Nor does Markus remedy this defect in Heath. The cited sections of Markus provide no disclosure of using “opportunity-specific data” to determine which slides are included in a slide presentation, as that term is defined in the present application. *See, e.g.,* Application, p.2 (“information that users have collected in connection with an opportunity, such as products, competitors, decision criteria, etc.”). Markus’s disclosed “registered user” data is not the claimed “opportunity-specific data.”

For the reasons presented above, neither MPP2000, Heath, nor Markus, alone or in combination, teach these limitations of independent Claims 9, 14 and 17. The burden is on the Examiner to support a case of obviousness, including whether the prior art references teach or suggest all of the claimed limitations. *See* MPEP 706.02(j).

Applicants also submit that the Office Action does not satisfy the burden of factually supporting a motivation to combine the references. The Examiner’s duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. The Examiner must therefore provide evidence to suggest the combination and “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not

‘evidence.’ ” See *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Further, the Office Action does not establish that such a combination of the teachings of these references would meet with success, as required.

Applicants respectfully submit that there is no suggestion to combine MPP2000 with the teachings of Markus. MPP2000 appears to be a printout of a presentation purportedly included with Microsoft PowerPoint 2000, purportedly published on or about 1999. The presentation appears to be a collection of slides that include bullet-pointed text and some graphics. MPP2000 is introduced by the Office Action as purportedly providing disclosure of the claim limitation: “presentation definition template having a plurality of component definitions, at least one component definition having an information bookmark,” a proposition with which Applicants do not necessarily agree. The Office Action admits that MPP2000 “does not teach mapping the information bookmark and the opportunity-specific data and automatically replacing the bookmark with the mapped data when creating the slide presentation.” Office Action, p.5 (a proposition with which Applicants do agree). The Office Action then introduces Markus as purportedly providing such disclosure, and then cites to the summary of Markus as support for such a proposition. The Office Action suggests that a person of ordinary skill might be motivated to perform such a combination because “Markus et al. taught that doing so would quickly and automatically fill out electronic presentations, relieving the user of the burden of manually inputting the data.” Office Action, p.4. Applicants respectfully submit, however, that the system disclosed by Markus is non-analogous to the disclosure of MPP2000 and therefore a person of ordinary skill in the art would not be motivated to provide such a combination.

Markus discloses a mechanism for purportedly including user-specific

information in a web-page form displayed on a client browser. Markus discloses using a remote server ("privacy bank") to purportedly store the user-specific information. The remote server also has registered sites, which purportedly provide the site-specific information needed for web-based forms generated by the registered site. The remote server/privacy bank then sends a Java Script profile to a client browser to purportedly fill in a web-based form, after a user identification is transmitted to the privacy bank. The client browser then purportedly runs the Java Script to fill in blanks in the web form. *See Markus 7:63-8:39.* Markus further discloses the privacy bank purportedly storing the user-specific information in association with a set of "standard field descriptors." There is then a mapping associated with the registered sites purportedly relating the standard field descriptors to a set of "non-standard field descriptors" found in the registered site's web-based form. *See Markus 9:2-12.* Markus then discloses purportedly including the standard field descriptor data in the Java Script in association with the non-standard field descriptors of the web-based form. The Java Script is sent to the client browser, which then purportedly inserts that information into the electronic form. Markus purports to provide this functionality as an aid to helping users to avoid the tedious task of filling in electronic forms with the same type of data.

Applicants respectfully submit that there is no suggestion to combine the web-based mechanism disclosed by Markus with the presentation slides provided by MPP2000. MPP2000 purports to provide a PowerPoint slide presentation, which is not a client browser display of a web page. There is no indication that the program associated with MPP2000 is capable of processing a Java Script routine, as provided by Markus. In addition, there is no indication from MPP2000 that there are identifiers for any of the purported information bookmarks that could be identified and used to determine the

appropriate “standard field descriptor” of Markus. Applicants therefore respectfully submit that for these reasons a person of ordinary skill in the art would not be motivated to combine MPP2000 with Markus.

Applicants respectfully submit that the arguments presented in the Office Action fail to establish a *prima facie* case of obviousness and run perilously close to a forbidden hindsight analysis of the references. The Office Action makes no showing of a motivation to combine MPP2000 with Markus from within the references themselves; therefore, it must be presumed that there is none. It is well-established that the best defense to hindsight is a “rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” *See Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000); *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000). A showing of combinability must be “clear and particular” and “broad conclusive statements about the teaching of multiple references, standing alone, are not ‘evidence.’” *See Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666 (Fed. Cir. 2000); *Brown & Williamson*, 229 F.3d at 1125.

The reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, “leading inventors to look to references relating to possible solutions to that problem.”

Ruiz, 234 F.3d at 665.

The Office Action presents nothing more than broad, generalized statements related to the motivation of a person of ordinary skill, which Applicants respectfully submit is insufficient to support a finding of obviousness. The Office Action does not

establish that the references which are combined are of special interest or importance in the field. Indeed, Markus is in the separate and distinct field of filling out fields in an electronic form document on a browser program using a remote server, rather than the field of Microsoft PowerPoint provided in MPP2000. Nor does the Office Action present any evidence of a problem to be solved from within those references themselves.¹ Instead, the Office Action fabricates such a problem to be solved, not from the teachings of the cited references, but from the teaching of Applicant's own disclosure.

Using Applicant's own disclosure as a blueprint for providing a motivation to combine prior art references in an obviousness determination is impermissible. *See W. L. Gore & Assoc. v. Garlock*, 721 F2d 1540, 1552-53 (Fed. Cir. 1983) ("to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher").

In addition, the Office Action fails to establish that a combination of the teachings of MPP2000 with the teachings of Markus would meet with success, as required. For the reasons discussed above, there is no reason to believe that the web-browser / Java Script-based teachings of Markus could be successfully incorporated in the PowerPoint environment of MPP2000. As noted above, MPP2000 provides no equivalent to the "non-standard field descriptors" of Markus, and therefore, Markus' disclosed mapping between non-standard and standard field descriptors could not be performed. Similarly, there is no indication that the purported Java Script functionality of Markus could

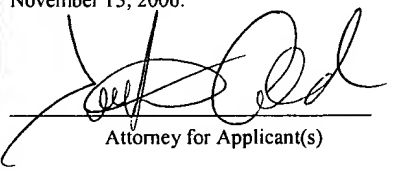
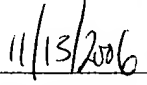
¹ There must be a finding that "there was a disadvantage to the prior systems, such that the "nature of the problem" will have motivated a person of ordinary skill to combine the prior art references." *Id.* At 666.

function in the PowerPoint environment of MPP2000. Therefore, Applicants respectfully submit that a combination of Markus with MPP2000 would not meet with success.

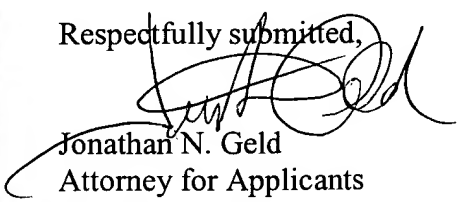
For these reasons, Applicants respectfully submit that the Office Action fails to present a *prima facie* case of obviousness of independent Claims 9, 14 and 17, as amended, and all claims dependent upon them, and that they are in condition for allowance. Applicants therefore respectfully request the Examiner's reconsideration and withdrawal of the rejections of those claims and an indication of the allowability of same.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, COMMISSIONER FOR PATENTS, P. O. Box 1450, Alexandria, VA 22313-1450, on November 13, 2006.	
	
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